



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,661	08/25/2003	Ernst Fischer	2322.68312	2139
24978	7590	10/18/2005		
GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606			EXAMINER CHOI, STEPHEN	
			ART UNIT 3724	PAPER NUMBER

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,661

Applicant(s)

FISCHER, ERNST

Examiner

Stephen Choi

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Upon further consideration, a new restriction requirement is made as follows.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - Group I. Claims 2-6, 12, 16, and 49 are, drawn to pencil sharpener having feed track, feed pencil, matching outer contour area, feed disk, and sealing device, classified in class 30.
 - Group II. Claims 7-9 and 17 are, drawn to a pencil sharpener having a pencil holding device being contained in the holding device in a rotationally fixed manner and the holding device is arranged opposite the cutting device in a movable manner, classified in class 30.
 - Group III. Claims 10-11 are, drawn to a pencil sharpener having a force feeding device guides the pencil at a free angle between 2 and 10 degrees, classified in class 30.
 - Group IV. Claims 18-28 and 50 are, drawn to a pencil sharpener with a rotational compartment with at least three cams and feed casing, wherein the compartment is moved in an axial direction of a maximum of three positions, classified in class 30.
 - Group V. Claim 32 is, drawn to pencil sharpener with a feed casing of non-constant wall thickness in the perimeter direction, classified in class 30.

Art Unit: 3724

Group VI. Claims 30-31, 33-36, 45-46, and 48 are, drawn to a pencil sharpener with rotational compartment having a support section of plate-like shape such that the it is supported in an axial direction on a well of the housing compartment that runs in a radial direction, and at least three cams, classified in class 30.

Group VII. Claims 37-44 and 47 are, drawn to a pencil sharpener with a housing compartment configured in a multi-part fashion, classified in class 30.

The inventions are distinct, each from the other because of the following reasons:

3. Claims 1, 13-15 and 29 will be examined with any of the elected groups. Claim 1 links inventions of Groups I-VII. The restriction requirement of the linked inventions is subject to the nonallowance of the linking claim, claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Art Unit: 3724

4. Inventions of Groups I-VII are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, pencil sharpener with the feed element/track and seal of Group I could be employed without the multi-part housing compartment of Group VII; and conversely, the multi-part housing compartment of Group VII could be employed without the feed element/track and seal of Group I. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. There is an excessive burden on the office to examine all of these inventions together, as shown by their search. See MPEP 808.02(C). For example, the sharpener of Group I will need to be search in class 30, subclass 454, along with a unique text search. Group VII would not be search as above, but would instead be searched in class 30, subclass 457 accompanied by a different text search. Groups I-VII all have unique searches.

7. This application contains claims directed to the following patentably distinct species of the claimed invention:

- Species A - The embodiment shown on Figure 1.
- Species B - The embodiment shown on Figure 8.
- Species C - The embodiment shown on Figure 12.

Art Unit: 3724

- Species D - The embodiment shown on Figure 18 with the embodiment shown on Figure 33.
- Species E - The embodiment shown on Figure 23 with the embodiment shown on Figure 33.
- Species F - The embodiment shown on Figure 28 with the embodiment shown on Figure 33.
- Species G - The embodiment shown on Figure 18 with the embodiment shown on Figure 34.
- Species H - The embodiment shown on Figure 23 with the embodiment shown on Figure 34.
- Species I - The embodiment shown on Figure 28 with the embodiment shown on Figure 34.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

Art Unit: 3724

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Thursday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3724

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SC
14 October 2005


STEPHEN CHOI
PRIMARY EXAMINER